FILE COPY

FILED
JAN 8 193
CHARLES ELMORE CRO

Supreme Court of the United States

October Term, 1935

No. 388

A. G. TRIPLETT, R. M. TRIPLETT, A. NELSON, C. M. TRIPLETT, JR., and THE BALTIMORE GASLIGHT COMPANY,
Defendants-Petitioners,

vs.

PERCIVAL D. LOWELL, FRANCIS W. DUNMORE, and DUBILIER CONDENSER CORPORATION,
Plaintiffs-Respondents.

BRIEF FOR PETITIONERS.

SAMUEL E. DARBY, JR.,
Counsel for Petitioners.

COOK & MARKELL,
Attorneys for Petitioners.

CHARLES MARKELL,
of Counsel.

INDEX

Nature of the Case 1

Opinions of the Courts below 2

Jurisdiction 2

Assignment of Errors 2

Statement of the Case 3

Summary of Argument 5

Argument 6

POINT I—The patents are invalid because the patentees not only failed to disclaim the claims which had been finally adjudicated to be invalid more than nine months prior to the filing of the bill of complaint in the present case, but they deny any necessity for doing so 6

The contentions of the parties 8

The disclaimer statute 9

The opinion of the Court of Appeals below 15

POINT II—The patents are invalid because the disclaimers which were filed by the patentees did not, in fact, disclaim, but purported to rewrite the claims to which they are directed 18

POINT III—The patents are invalid because the patentees unreasonably neglected or delayed to enter a disclaimer of the invalidated claims subsequent to final adjudication of invalidity thereof 22

Conclusion 27

PAGE

Appendix A 28

Disclaimer as to Dunmore Patent No. 1,635,117 28

Disclaimer as to Lowell and Dunmore Patent No. 1,455,141 30

Appendix B 35

Section 4917 R. S. 35

Section 4922 R. S. 36

Appendix C 37

The cases cited by the Court of Appeals for the Fourth Circuit in the footnote to its decision, and referred to as establishing "long continued practice in patent cases inconsistent" with petitioner's contentions here made 37

Cases in the Supreme Court prior to the establishment of the Circuit Courts of Appeals (prior to the Act of 1891) 37

Cases in the Supreme Court where the patent was held invalid by the Circuit Court of Appeals for one Circuit and later held valid by the Circuit Court of Appeals for another Circuit 38

Cases in Circuit Courts of Appeals where the patent was first held to be invalid by one Circuit Court of Appeals and later held to be valid by another Circuit Court of Appeals (omitting cases which reached the Supreme Court) 43

Summary 47

List of Cases.

PAGE

Altoona Publix Theatres v. American Tri-Ergon, 294 U. S. 477 ..... 3, 21
Bassick Manufacturing Co. v. Adams Grease Gun Corp., 39 Fed. (2) 904 ..... 24, 25
Bassick Manufacturing Co. v. Adams Grease Gun Corp., C. C. A. Second, 52 Fed. (2) 36 ..... 14, 24
Better Packages v. Link, 74 Fed. (2) 679 ..... 16, 24
Better Packages, Inc. v. Nashua Package Sealing Co., C. C. A. Second, 74 Fed. (2) 682 14
Emery v. J. G. McCrory Co., 4 Fed. Supp. 167 ..... 15, 24
Ensten v. Simon Ascher, 39 Fed. (2) 71 23
Ensten v. Simon Ascher & Co., 282 U. S. 455 ..... 13, 22
Excelsior v. Williamson Heater Co., 269 Fed. 614 24
General Chemical Co. v. Standard Wholesale Phosphate & Acid Works, Inc., 8 Fed. Supp. 265 25
General Chemical Co. v. Standard Wholesale Phosphate & Acid Works, Inc., C. C. A. Fourth, 77 Fed. (2) 230 25
Herman v. Youngstown Car Manufacturing Co., 191 Fed. 579 24
Higgin Manufacturing Co. v. Watson, 263 Fed. 378 24
R. Hoe & Co. v. Goss Printing Press Co., 31 Fed. (2) 565 ..... 12, 23
Lowell, et al. v. Radio Corporation of America, 50 Fed. (2) 305 3
Lowell, et al. v. Radio Corporation of America, 50 Fed. (2) 309 3
Lowell, et al. v. Triplett, et al., 77 Fed. (2) 556 ..... 2, 18
The Mantle Lamp Company of America v. Aluminum Products Company (No. 590 pending in this Court) 7, 17
Minerals Separation v. Butte, 250 U. S. 336 26
Otis Elevator Co. v. Pacific Finance Corp., 68 Fed. (2) 664 ..... 15, 25
Radio Condenser Co. v. General Instrument Corp., 65 Fed. (2) 458 14
Radio Corp. v. Radio Engineering Laboratories, 293 U. S. 1 17
Railway Engineering E. Co. v. Oregon Short Line R. Co., 79 Fed. (2) 469 25

Cases Cited in Appendix C.

	PAGE
Abercrombie & Fitch v. Baldwin, 245 U. S. 198	39
Backstay Machine & Leather Co. v. Hamilton, 262 Fed. 411	46
Corona Cord Tire Co. v. Dovan Chemical Corp., 276 U. S. 358	42
Diamond Rubber Co. v. Consolidated Rubber Tire Co., 220 U. S. 428	38
Dowagiac Manufacturing Co. v. Minnesota Moline Plow Co., 235 U. S. 641	39
Expanded Metal Co. v. Bradford, 214 U. S. 366	38
Franc-Strohmenger & Cowan v. Arthur Siegman, 27 Fed. (2) 785	47
Hanover Star Milling Co. v. Metcalf, 240 U. S. 403	39
Imperial Bottle Cap and Machine Co. v. Crown Cork & Seal Co., 139 Fed. 312	45
Maitland v. B. Goetz Manufacturing Co., 86 Fed. 124	43
McNeely v. Williames, 96 Fed. 978	43
Mecanno Limited v. John Wanamaker, 253 U. S. 136	41
New York Scaffolding Co. v. Chain Belt Co., 254 U. S. 32	41
Pieper v. S. S. White Dental Manufacturing Co., 228 Fed. 30	46
Radio Corp. v. Radio Engineering Laboratories, 293 U. S. 1	43
Railroad Supply Co. v. Elryia Iron & Steel Co., 244 N. S. 285	39
Saranac Automatic Machine Corp. v. Wirebounds Patents Co., 282 U. S. 704	42
T. H. Symington v. National Malleable Castings Co., 250 U. S. 383	40
John E. Thropp's Son's Co. v. Seiberling, 264 U. S. 320	41
Thompson-Houston Electric Co. v. Black River Traction Co., 135 Fed. 759	45
Wenborne-Karpen Dryer Co. v. Cutler Dry Kiln Co., 290 Fed. 625	46
Westinghouse Electric & Manufacturing Co. v. Stanley Instrument Co., 133 Fed. 167	44

Supreme Court of the United States

October Term, 1935

No. 388

A. G. TRIPLETT, R. M. TRIPLETT, A. NELSON, C. M. TRIPLETT, JR., and THE BALTIMORE GASLIGHT COMPANY,
Defendants-Petitioners,

vs.

PERCIVAL D. LOWELL, FRANCIS W. DUNMORE, and DUBILIER CONDENSER CORPORATION,
Plaintiffs-Respondents.

BRIEF FOR PETITIONERS.

Nature of the Case.

This is a patent infringement suit brought by plaintiffs-respondents as owners of Lowell and Dunmore Patent No. 1,455,141 and Dunmore Patent No. 1,635,117.

The defendants-petitioners are copartners operating a retail store in Baltimore, Maryland, under the name of The Baltimore Gaslight Company. Their sale of a Stewart-Warner radio broadcast receiver is the act charged to constitute infringement of claims 1 to 4, 13 and 14 of Patent No. 1,455,141, and claims 9, 11 and 12 of Patent No. 1,635,117.

Opinions of the Courts below.

Judge COLEMAN, in the District Court of Maryland, dismissed the bill of complaint as to the two patents because plaintiffs unreasonably delayed in adequately disclaiming claims of the patents which previously had been declared to be invalid by the Court of Appeals for the Third Circuit. The opinion of the District Court is unreported, but is found in Volume I of the Record, page 263.

The Court of Appeals for the Fourth Circuit reversed the decree of the District Court, and ordered the cause remanded for trial on the merits of the issues of validity and infringement raised by the pleadings (77 Fed. [2] 556).

Jurisdiction.

The case is here on writ of certiorari granted by this Court on December 9th, 1935, jurisdiction having been invoked under Section 347 U. S. Code, Title 28 (80 L. Ed. 222).

Assignment of Errors.

1. The Court of Appeals erred in reversing the decree of the District Court and reinstating the bill of complaint as to the two patents in suit.

2. The Court of Appeals erred in failing to hold the two patents invalid because of the invalid disclaimers filed with respect thereto.

3. The Court of Appeals erred in failing to hold the two patents invalid for failure to file adequate disclaimers of the invalid claims within a reasonable time after the

invalidation thereof and prior to the filing of the bill of complaint, which was more than nine months subsequent to the finality of invalidation.

Statement of the Case.

In the two cases of *Lowell et al.* v. *Radio Corporation of America* (50 Fed. [2] 305,309) Judge WOOLLEY, speaking for the Court of Appeals for the Third Circuit, found claim 9 of Patent No. 1,635,117 and claims 3 and 14 of Patent No. 1,455,141 to be invalid on the ground that they covered mere unpatentable aggregations, and defined no patentable invention over what was well known and in use in the prior art. Petitions for rehearing were denied on July 6th, 1932, and this Court denied writs of certiorari on October 25th, 1932 (287 U. S. 648, 650).

On July 8th, 1933—*eight months and thirteen days after the denial of certiorari*—plaintiffs filed disclaimers in the Patent Office with respect to certain claims of each of the patents, including the claims which had been held to be invalid.* The disclaimers, however, did not purport to disclaim the invalid claims. On the contrary, the admitted intent and effect of the disclaimers was to import into the claims limitations not therefore included therein. In other words, the disclaimer filed with respect to each of the patents was of the type and in the form condemned by this Court in *Altoona Publix Theatres* v. *American Tri-Ergon*, 294 U. S. 477.

---

* The disclaimers are printed in full at the end hereof as Appendix A (pp. 28-35).

Indeed, plaintiffs contended in the Courts below that the claims should be treated as though no disclaimers had been filed.

The District Court said as to the disclaimers (Vol. I, p. 263):

> "they seem to me not to disclaim at all".

The Court of Appeals below based its decision on an assumption to that effect. It said (Vol. I. p. 424; 77 Fed. [2] 556, 559):

> "We may assume, for the purposes of the pending case, that in effect no disclaimer has been filed as to the claims passed on in the Third Circuit * * * ".

On August 17, 1933—*over nine months after the denials of certiorari*—plaintiffs filed the present suit in Maryland charging infringement of the invalidated claims of the two patents, as well as of other claims in both patents which were not involved in the prior suits. The defendants in the present suit are not connected in any way with the defendant in the cases in the Third Circuit.

When the case was called to trial, defendants presented a motion to dismiss the bill of complaint as to the two patents on the ground that plaintiffs' delay of eight months and thirteen days in filing disclaimers of the invalidated claims of the patents was unreasonable, and, in consequence, the patents were wholly invalid (Vol. 1, p. 19). The District Court denied this motion (Vol. 1, p. 46).

Thereupon, defendants presented a motion to dismiss the bill of complaint as to the two patents on the ground that no adequate disclaimer had been filed because of the

admitted fact that the disclaimers did not purport to, or in fact, disclaim anything, but merely imported into the claims limitations not theretofore included therein (Vol. 1, p. 55).

Though admitting that no disclaimers had been filed, or were intended to have been filed to meet the invalidating decisions of the Third Circuit Court of Appeals, plaintiffs opposed this motion on the ground that there was nothing to compel them to file disclaimers, and thereby avail themselves of the benefits of the disclaimer statute; that the provisions of the disclaimer statute were applicable to only those patentees who voluntarily sought to avail themselves of the proffered benefits thereof; that the decisions of the Circuit Court of Appeals for the Third Circuit invalidating some of the claims of the two patents were effective only against the defendant in those cases; and that the plaintiffs by *not* disclaiming the invalidated claims could sue on those claims, as well as on other claims, in any Circuit, at any time during the terms of the patents.

The District Court granted the second motion and dismissed the bill as to the two patents (Vol. I, pp. 71, 263).

The Court of Appeals for the Fourth Circuit reversed the District Court, sustained plaintiffs' contentions, and remanded the case for a trial on the merits (77 Fed. [2] 556.*

Summary of Argument.

1. The patents are invalid because the patentees not only failed to disclaim the claims which had been finally adjudicated to be invalid more than nine months prior

---

* The litigation involved a third patent. We are not here concerned with the disposition thereof made by the Court of Appeals.

to the filing of the bill of complaint in the present case, but they deny any necessity for doing so.

2. The patents are invalid because the disclaimers which were filed by the patentees did not, in fact, disclaim, but purported to rewrite the claims to which they are directed.

3. The patents are invalid because the patentees unreasonably neglected or delayed to enter a disclaimer of the invalidated claims subsequent to final adjudication of invalidity thereof.

ARGUMENT.

POINT I.

The patents are invalid because the patentees not only failed to disclaim the claims which had been finally adjudicated to be invalid more than nine months prior to the filing of the bill of complaint in the present case, but they deny any necessity for doing so.

Although the patentees in this case did file disclaimers eight months and thirteen days after the refusal of this Court to review the cases in which the Circuit Court of Appeals for the Third Circuit held specific claims of each of the patents to be invalid, plaintiffs contended in the Courts below, and the Court of Appeals below held, that because the disclaimers did not disclaim the invalid claims, and were not intended to do so, the claims should be regarded as though no disclaimers had been filed with respect thereto.

For the purposes of this first point of our argument we accept plaintiffs' contention and the decision of the Court below to that effect, and regard the patents as though no disclaimers have been filed as to the invalidated claims therein.

Thus, the question here presented is whether or not the plaintiffs may maintain the present suit, against a defendant different from the one involved in the Third Circuit cases, on either the invalidated claims or any other claims of the patents.

In the case of *The Mantle Lamp Company of America* v. *Aluminum Products Company* (No. 590 in this Court, immediately after the argument of which the present case is assigned for presentation) there have been certified to this Court by the Court of Appeals for the Seventh Circuit three questions, the first of which is:

> "Where certain but not all of the claims of a patent are in suit, and all of the claims in suit are held and decreed to be invalid pursuant to a finding and judgment to that effect of the Circuit Court of Appeals of the Circuit, may the owner of the patent maintain a suit afterward brought thereon *in the same judicial circuit* as that in which the first cause was decided, and against a different defendant not involved in the first suit—the second suit being based on the claims held in the prior suit to be invalid and on other claims of the same patent not previously adjudicated—where the owner of the patent wholly failed and omitted to file any disclaimer of the claims held in the first suit to be invalid, and where, between entry of decree of invalidity of the claims in the first suit and the bringing of the second suit *in the same cir-*

cuit, reasonable time had elapsed for filing such disclaimer."*

It will be noted that the foregoing question is limited to the case where the second suit is instituted *in the same judicial circuit* in which the final adjudication of invalidity had previously occurred. In the present case the same question is presented where the second suit, under the same recited circumstances, is filed in a circuit *other* than that in which the final adjudication of invalidity had previously occurred. In other words, the question here presented is—may a patentee, after an unreasonable length of time subsequent to a final decree of invalidation, institute or maintain a suit *anywhere* on the invalidated claims, or (in the absence of a disclaimer of the invalidated claims) on any remaining claims in the patent?

The contentions of the parties.

Respondents insist that by reason of their refusal to disclaim the previously invalidated claims they have the right to bring suit on *any* claims of the patents, *specifically including the invalidated ones,* against any alleged infringer (other than the previous defendant, as to whom the doctrine of *res adjudicata* would apply) in *any* circuit, at *any* time during the terms of the patents.

Petitioners, on the other hand, contend that when one or more claims of a patent have been finally declared to be invalid, the patentee may not *thereafter* institute or maintain a suit in any Court, *on the invalidated claims;* and that moreover, the patentee may not institute or maintain such a suit on any *other* claims of the patent if he has unreason-

* Italics in this brief are ours.

ably neglected or delayed to enter a disclaimer of the invalid claims after the adjudication of invalidity thereof.

Petitioners assert that their contention is based on and supported by the express provisions of the disclaimer statute, as well as by the decisions of this Court and the Circuit Court of Appeals of the Second Circuit.

The disclaimer statute.

Section 4922 R. S., 35 U. S. C. 71, provides—

> "Whenever • • • a patentee has • • • claimed to be the original and first inventor of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee • • • *may maintain a suit* at law or in equity, for the infringement of *any part thereof which was bona fide his own* • • • notwithstanding the specification may embrace more than that of which the patentee was the first inventor or discoverer. • • • *But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer.*" •

It will be seen that the statute grants permission to "maintain" a suit on a patent *with* invalidated claims therein, *but only on claims other than those which have been invalidated,* and only if there has been *no unreasonable delay in disclaiming the invalidated claims.*

Obviously, if no suit may be *maintained* except on those conditions, no suit may be *instituted* except on those conditions.

• Sections 4917 and 4922 R. S. are reproduced in full at the end hereof as Appendix B (pp. 35-36).

The meaning of the statute is clear, and there is no limitation therein stated or implied as to its application. It obviously applies to *all* of the Courts within the jurisdiction of the statute. It applies to the Circuits other than the one in which the prior adjudication of invalidity occurred, as well as to that particular Circuit. No distinction between them is expressed or implied, and none is warranted by any extraneous considerations.

Thus, the language of the statute precludes the thought that a patentee can institute or maintain a suit on previously invalidated claims.

Such a conclusion does not deprive a patentee of any rights to which he is justly entitled. As a matter of public policy, monopolies are in derogation of the public right. A patent monopoly is created by statute in derogation of the public right. Being a creature of statute, a patent is granted only on prescribed statutory conditions, which if not met, prevent a valid grant. Its validity is subject to attack for failure to comply with the statutory requirements each time that it is sought to be enforced. Thus, if a patent is sought to be enforced in one Judicial Circuit and the grant is adjudged valid, that adjudication justly carries great weight, by virtue of the doctrines of *stare decisis* and comity, in subsequent suits by which it is sought to enforce the monopoly. But, in any such subsequent suit, it is possible for the defendant to establish the invalidity of the monopoly, for example, by new evidence not theretofore considered. In this way the public right is safeguarded, and the patentee's rights are protected by being reasonably assured of a review by this Court, because of diversity of opinion, if invalidity is found in the subsequent proceedings.

On the other hand, if, in the suit of first instance, a Court of competent jurisdiction has finally determined the asserted monopoly to be invalid, there is no logical reason why a monopoly, thus invalidated, should be allowed to be again asserted as a basis for further litigation anywhere in the judicial system.

The patentee has not been deprived of his day in Court. His asserted monopoly has been considered, and adversely passed upon. The adverse adjudication has either been accepted or appellate relief exhausted. There is no justification in the statute or in logic for expanding the litigant's proverbial "day in Court" to "a day in a Court of each Judicial Circuit."

It is illogical that Courts of similar jurisdiction should be required to review the same patent grant that has received full consideration by one of them and found to be wanting in legal justification.

Moreover, the patent grant, created by statute in derogation of the public right, can be enforced only in the manner and to the extent expressly prescribed by the statute which created it. There is no expressed or implied sanction in the statute for an attempted enforcement of an invalidated monopoly subsequent to its invalidation. On the other hand, there is the express provision of the disclaimer statute which precludes the attempted enforcement of the monopoly represented by patent claims previously adjudicated to be invalid, by limiting statutory permission of further litigation on the patent to the claims *other* than the invalidated ones, and only if a disclaimer of the invalid claims is filed without unreasonable delay.

It follows, both as a matter of logic and of interpretation of the plain language of the statute, that after a patent

claim has been finally adjudged to be invalid it must be disclaimed, and only by *prompt* disclaimer thereof can there be preserved any enforceable rights that may remain in the patent.

That this is the correct interpretation of the statute has been implied by a recent decision of this Court, and has been expressly held by the courts in the Second Circuit.

Thus, addressing himself directly to the question, Judge LEARNED HAND, speaking for the Court of Appeals for the Second Circuit, in *R. Hoe & Co.* v. *Goss Printing Press Co.*, 31 Fed. (2) 565, said (p. 566):

> "The plaintiff at bar goes further, however, arguing that, even after denial of an application for certiorari, the patentee should not be obliged to disclaim. It argues that the Circuit Court of Appeals of another circuit might disagree with our ruling, and the Supreme Court would then take the case on certiorari and might declare the claims valid. A disclaimer would merely destroy this right, though the defendant is protected forever by its decree, and really has no interest in the disclaimer at all. While we acknowledge the difficulty and the possibility, it appears to us that so to extend the patentee's time might result in avoiding the statute altogether. The patentee may not sue again, or, if he does, the result may be the same. It does not follow, because two Circuit Courts of Appeals have held the same way, that a third will not disagree. Must the patentee disclaim at the conclusion of the second suit, or may he wait until all nine circuits have passed upon his claims? The question is at best of seasonable action, and in practice there must be some end, short of exhausting all conceivable remedies. *When the patent has once passed through all the courts then available, the statute should have its effect; else the putatively*

invalid claims may remain as scarecrows, preserved against the bare possibility that at some future time they may come to life."

This Court in *Ensten* v. *Simon Ascher & Co.*, 282 U. S. 455, 75 L. Ed. 453, said:

"The two sections (Sections 4917 and 4922 R. S.) 'are parts of one law having one general purpose, and that purpose is to obviate the inconvenience and hardship of the common law, which made a patent wholly void if any part of the invention was wrongfully claimed by the patentee, and which made such a defect in a patent an effectual bar to a suit brought upon it'. Construed together, they 'enact that where a patentee claims materially more than that which he was the first to invent, his patent is void, unless he has preserved the right to disclaim the surplus; and that he may fail to preserve the right, by unreasonable neglect or delay to enter a disclaimer in the Patent Office.' Walker on Patents, 6th ed., §254.

The statute is remedial; the intent is to aid the inventor free from wilful default or intention to mislead the public by permitting him to avoid the consequence of inadvertence, accident or mistake through prompt disavowal of the apparent right to exclude others from something improperly included in the words of his grant. *Escape is permitted only to one who acted originally in good faith and who has complied with the prescribed conditions.* 'The same principle which forbids a patentee to assert a right to more than he has actually invented compels him to disavow the right as soon as he discovers that it has been unjustly claimed. Unreasonable delay in disclaiming is thus tantamount to an original fraudulent claim, and through it the patentee loses the privilege

of making the amendment by which alone his patent could be saved."

Speaking of the time when the patentee "discovers" the invalid subject matter in his patent, this Court said:

> "In cases where the excess is not apparent at once upon the inspection of the patent by the patentee, the allowance of his claim by the Patent Office raises such a presumption in its favor that he may rely on its validity *until a court of competent jurisdiction decides that it is broader than his real invention.*"
>
> * * * * * * *
>
> "the disclaimer provisions permit him to deprive the public temporarily of complete freedom from the assertion of a monopoly apparently valid, but not so in fact. *When a competent court has declared his pretensions without sufficient foundation, we think good faith and the spirit of the enactment demand that he act with such promptness as the circumstances permit* either to vindicate his position or to relieve the public from further evil effects of his false assertion. But for the benign provisions of the statute, such an assertion would invalidate the whole patent; and these provisions were intended to protect only those who by prompt action either seek to overturn an adverse ruling or retreat from a false position."

See also:

Radio Condenser Co. v. *General Instrument Corp.*, C. C. A. 2nd, 65 Fed. (2) 458;

Bassick Manufacturing Co. v. *Adams Grease Gun Corp.*, C. C. A. 2nd, 52 Fed. (2) 36;

Better Packages Inc. v. *Nashua Package Sealing Co.*, C. C. A. 2nd, 74 Fed. (2) 682;

Otis Elevator Co. v. *Pacific Finance Corp.*, C. C. A. 9th; 68 Fed. (2) 664;
Emery v. *J. G. McCrory Co.*, D. C. E. D. N. Y., 4 Fed. Supp. 167.

In all of the above cases the obligation imposed upon the patentee by the disclaimer statute was clearly recognized as compulsory. As this Court stated in the *Ensten* case, *supra*, the disclaimer statute was the *only* escape from the invalidation of the entire patent as a consequence of the patentee claiming more than that to which he was entitled.

The opinion of the Court of Appeals below.

The Court of Appeals for the Fourth Circuit in the present case reached a different conclusion from that above expressed. It not only concluded that the statute imposed no obligation upon the patentee to disclaim subject matter which had been previously and finally invalidated, but it also stated that a patentee who denies the necessity of filing the disclaimer is not "to be held to the same rigid rule, as to prompt action" as is the patentee who does file a disclaimer pursuant to the dictate of the statute.

The logical consequence of the decision below is that a patentee who does not enter a disclaimer of invalidated claims in his patent, is in a more advantageous position than one who complies with the provisions of the statute. He is placed in a class by himself, and put in a position where he can, with immunity, assert "a monopoly apparently valid, but not so in fact."

Not only is such a conclusion opposed to the express provisions of the statute itself, but it also flatly controverts the

statement of this Court in the *Ensten* case, that but for the benign provisions of the statute, such an assertion invalidates the patent in its entirety.

The Court of Appeals for the Second Circuit addressed itself to the fallacy of such an argument. In *Better Packages v. Link*, 74 Fed. (2) 679, the Court said:

> "The plaintiff's argument that a patentee gains a better position by filing no disclaimer at all than by disclaiming late is wholly fallacious. *It is not his tardy disclaimer which forfeits the patent, but the introduction of unpatentable claims; and forfeiture for this fault is excused by a prompt disclaimer.*"

In consequence, the plaintiffs stand here before the Court deprived, by their own deliberate action, of the "benign provisions of the statute." They have deliberately and wilfully refrained from taking the step which constituted the *only escape* from the complete invalidation of their patents by reason of the undisclaimed invalidated claims therein.

The Court of Appeals below suggested that its conclusion was consistent with "the long continued practice in patent cases" (77 Fed. [2] 556, at p. 561). In support thereof the Court listed, in a footnote to its opinion, a large number of patent cases in which presumably a decree of validity was secured in a suit instituted subsequent to a final adjudication of invalidity. The list of cases, their grouping, and the facts recited with respect thereto, were copied *verbatim* from a memorandum prepared by counsel for plaintiffs at the request of the Court subsequent to the oral argument of the case. Because of the fact that, with but three exceptions, the recitation of facts with respect

to these cases is either erroneous or incomplete, we have added at the end hereof (as Appendix C, pp. 37 *et seq.*) a correct recitation of facts with respect to these cases. However, at this point it is sufficient to completely dispose of the suggestion of the Court of Appeals below, and of the cases cited in the footnote to its decision, by the following two simple statements.

1. In none of the cases cited was the effect of the disclaimer statute, as here presented, at issue or called to the attention of the Court.

2. All of the cases cited were decided prior to the decision of this Court in *Ensten* v. *Simon Ascher Co.*, *supra* (with the single exception of the case of *Radio Corp.* v. *Radio Engineering Laboratories*, 293 U. S. 1, which has no relevancy to the present issue).

Of course, complete consideration of the questions here presented involves the query of whether or not a patentee may continue the prosecution of a suit brought for infringement of a claim of his patent *prior* to a final adjudication of invalidity of that claim. In substance this query constitutes the third question certified to this Court in the case of *The Mantle Lamp Company of America* v. *Aluminum Production Company*. A determination of that question is not necessary for a disposition of the present case in view of the fact that *plaintiffs did not file the present suit until more than nine months subsequent to the final decree of invalidation of the claims they here seek to press.* However, it is submitted that the wording of the disclaimer statute is that the patentee "may maintain" a suit only on the conditions prescribed therein, as hereinbefore developed at

length. It is believed that by the use of this language the statute was designed to prevent the question of the *time of instituting* the suit from having any effect upon the applicability of its provisions, except as to recovery of costs.*

It is submitted, therefore, that the decision of the Court of Appeals below, that by not entering disclaimers of their previously invalidated claims plaintiffs preserved any enforceable right therein, is not only unsupported by the statute, but is quite contrary to the spirit, intent, and express provisions thereof, and contrary to the decision of this Court in the *Ensten* case, and should be reversed.

POINT II.

The patents are invalid because the disclaimers which were filed by the patentees did not, in fact, disclaim, but purported to rewrite the claims to which they are directed.

The disclaimers which were filed by respondents with respect to both the patents in suit admittedly disclaim

* Section 4922 provides (see Appendix B, p. 36), "But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered in the Patent Office before the commencement of the suit". In other words, if, during the pendency of a suit in one court, another court finally holds a claim to be invalid, the patentee "may maintain" the first suit on *other* claims of the patent by promptly disclaiming the invalidated claim, but, in case he then prevails he cannot recover costs because the disclaimer was not filed before instituting the suit. This is the relatively inconsequential penalty he pays for *inadvertently* asserting "a right to more than he has actually invented".

nothing. The Court of Appeals said in its opinion (Vol. I, p. 424; 77 Fed. [2] 556, 559):

> "We may assume, for the purpose of the pending case, that in effect no disclaimer has been filed as to the claims passed on in the Third Circuit, for even if the delay of 8 months is satisfactorily accounted for, the plaintiff admits, as the defendants contend and the District Judge held, that the so-called disclaimers disclaimed nothing and amounted only to an admission that the broad language of the claims should be limited to the disclosures of the specifications, in accordance with the well established rule."

An examination of the disclaimer as filed in connection with claim 9 of Patent No. 1,635,117 (Appendix, p. 28) demonstrates this. The patentee purported to disclaim:

> "Any 'filament electrodes' specified in claim 9 except such as are energized by raw alternating current; and any 'means for supplying a negative potential to the grid electrode of said electron tube from said source of alternating current' as specified in claim 9 except such means as comprise a bias determining resistance connected in a series path between the grid and filament electrodes and shunted by a condenser of low impedance to power supply frequencies."

Similarly, with respect to claim 3 of Patent No. 1,455,141 (Appendix, p. 31), the disclaimer filed by the patentees purported to disclaim:

> "Any 'source of alternating current for supply power to said amplifying means' as set forth in claim 3 except such as supplies raw alternating current to the cathode heating circuit or circuits and rectified

current to the plate circuit or circuits of such amplifying means; to any 'separate means connected to each of said amplifying and rectifying means for eliminating the hum of said alternating current' except as comprises: (a) connecting the grid of the amplifying means to the cathode thereof at a point not subjected to the influence of variations of the cathode heating current; and (b) elements connected between the 'means for amplifying said signal energy at radio frequencies' and the 'means for rectifying said energy' which prevent the passage of power supply frequencies."

With reference to claim 14 of this patent the patentees entered their disclaimer:

"To any 'means in each of circuits for eliminating the hum' as set forth in claim 14, except as comprises: (a) connecting the grids of vacuum tubes to the cathodes thereof at a point not subjected to the influence of variations of the cathode heating current, and (b) interconnecting the plurality of vacuum tubes which amplify the signal energy at radio frequencies through elements which prevent the passage of power supply frequencies."

Thus, the patentees, by their disclaimers, have attempted to rewrite the claims without affording the Patent Office an opportunity to pass on the novelty thereof as rewritten.

This Court, in *Altoona Publix Theatres* v. *American Tri-Ergon,* 294 U. S. 477, held this type of disclaimer invalid as unwarranted by the disclaimer statute. Moreover, the original claims, as to which the invalid disclaimer was filed,

were likewise held to be invalid because thereof. This Court said (at p. 491):

> "With the invalid disclaimer must fall the original claims as they stood before the disclaimer. The disclaimer is a representation, as open as the patent itself, on which the public is entitled to rely, that the original claim is one which the patentee does not in the language of the statute 'chose to claim or hold by virtue of the patent.' Upon the filing of disclaimers the original claims were withdrawn from the protection of the patent laws, and the public was entitled to manufacture and use the device originally claimed as freely as though it had been abandoned. To permit the abandoned claim to be revived, with the presumption of validity, because the patentee had made an improper use of the disclaimer, would be an inadmissible abuse of the patent law to the detriment of the public."

It will be noted that in the present case claims 9, 11 and 12 of Patent No. 1,637,117 are involved in the suit, and that the invalid disclaimer was filed with respect to each thereof. Similarly, claims 1 to 4, 13 and 14 of Patent No. 1,455,141 are involved in the present suit, and the invalid disclaimer was filed with respect to each thereof.

It follows, therefore, that each of the claims of the patents in suit in the present case are invalid because of the invalid disclaimers that were filed by the patentees with respect thereto, and that, in consequence, the District Court committed no error in dismissing the bill of complaint by reason thereof.

In consequence, the decision of the Court of Appeals for the Fourth Circuit was in error and should be reversed.

POINT III.

The patents are invalid because the patentees unreasonably neglected or delayed to enter a disclaimer of the invalidated claims subsequent to final adjudication of invalidity thereof.

The patentees in the present case filed their disclaimers eight months and thirteen days after this Court had declined to review the decisions of the Court of Appeals for the Third Circuit which invalidated the designated claims of the two patents.

The question, thus presented, is whether or not that period of time constituted an "unreasonable" delay.

The statute itself does not provide any guide by which it may be determined what does or does not constitute "unreasonable" delay. Likewise, we find no decision of this Court which expressly fixes a period of delay which may be designated as "reasonable," any excess of which would be "unreasonable."

In the *Ensten* case, *supra,* this Court definitely fixed the time when the period of delay begins. It said:

> "Delay begins whenever the patentee becomes aware that he has claimed more than he has invented or described. In cases where the excess is not apparent at once, upon the inspection of the patent by the patentee, the allowance of his claim by the Patent Office raises such a presumption in its favor that he may rely on its validity *until a Court of competent jurisdiction decides that it is broader than his real invention.*"

This Court further said:

> "When a competent court has declared his pretensions without sufficient foundation, we think good faith and the spirit of the enactment demand that he act with such promptness as the circumstances permit either to vindicate his position or to relieve the public of further evil effects of his false assertion."

Although this Court did not fix the time, the inference is that in affirming the decree of the Court of Appeals for the Second Circuit, this Court approved the rule stated in the decision of the Court of Appeals that, except under exceptional circumstances, a delay of more than thirty days after the finality of decision of invalidity is "unreasonable" under the statute.

The Court of Appeals for the Second Circuit in the earlier case of *R. Hoe & Co.* v. *Goss Printing Press Co.*, C. C. A. 2nd, 31 Fed. (2) 565, said (at p. 566):

> "The mandate will therefore be recalled and amended, so as to require the plaintiff to file a disclaimer within thirty days after the time expires within which to petition for certiorari, or, if it does so petition, then within thirty days after denial, if it is denied, or affirmance of the decree, if it is granted, and the decree is affirmed."

In the *Ensten* case (38 Fed. [2] 71) the Court of Appeals referred to its prior decision in *Hoe* v. *Goss*, and stated that in that case:

> "we required the plaintiff either to petition for certiorari, or file a disclaimer within thirty days after expiration of the time for such a petition. The logic of that decision is equally applicable to an inter-

> locutory decree of the District Court. * * *. Adherence to the Hoe case requires an affirmance of the decree below."

In *Bassick Manufacturing Co.* v. *Adams Grease Gun Corp.*, 39 Fed. (2) 904, District Judge THATCHER cited the "thirty day" rule, but refused to dismiss the bill of complaint before him because—"plaintiff at bar did not wait so long". The Court of Appeals for the Second Circuit, on the appeal from Judge THATCHER's ruling, affirmed for that reason (52 Fed. [2] 36).

In *Better Packages* v. *Link*, 74 Fed. (2) 679, the Court of Appeals for the Second Circuit said (p. 680):

> "In the absence of special circumstances, such as existed in Minerals Separation vs. Butte, etc., Mining Co., 250 U. S. 336, 354, 39 S. Ct. 496, 63 L. Ed. 1019, thirty days after expiration of time for appeal would seem ample time within which to prepare and file the document required by law to avoid forfeiture of the patent."

See also:

Emery v. *J. G. McCrory*, 4 Fed. Supp. 167.

The Court of Appeals for the Sixth Circuit has likewise adopted the "thirty day" rule.

Herman v. *Youngstown Car Manufacturing Co.*, 191 Fed. 579, 587, 588;

Higgin Manufacturing Co. v. *Watson*, 263 Fed. 378, 387;

Excelsior v. *Williamson Heater Co.*, 269 Fed. 614, 619.

Likewise, the Court of Appeals for the Ninth Circuit in *Otis Elevator Co.* v. *Pacific Finance Corp.*, 68 Fed. (2) 664, by citing with approval the decision of the Court of Appeals for the Second Circuit in *Bassick* v. *Adams*, 39 Fed. (2) 904, has indicated approval of the rule.

Also, the District Court for the District of Maryland in *General Chemical Co.* v. *Standard Wholesale Phosphate & Acid Works, Inc.*, 8 Fed. Supp. 265, carefully reviewed the authorities, and upon sound logical reasoning, fully set forth in its opinion, approved and adopted the "thirty day" rule of the Second Circuit. The Fourth Circuit Court of Appeals, following the same fallacious theory which prompted its decision in the case at bar, reversed the District Court in the *General Chemical* case (77 Fed. [2] 230).

On the foregoing, it is here contended that an allowance of thirty days, after finality of invalidation, is ample, except in extraordinary circumstances, for the filing of a disclaimer of finally invalidated claims, and is in keeping with the spirit and intent of the statute, as construed by this Court, of requiring exceptionally prompt action on the part of the patentee to free the public from the assertion of an invalid monopoly.

The fact that the statute requires rigid promptness of an extraordinary character has recently been recognized by the Court of Appeals for the Tenth Circuit in *Railway Engineering E. Co.* v. *Oregon Short Line R. Co.*, 79 Fed. (2) 469, where the dilatory entry of a decree fifty-one days after the decision of invalidity, and the dilatory appeal therefrom eighty-nine days after the entry of the decree, were found by the majority of the Court to constitute "unreasonable" delay under the statute.

If this Court adopts the "thirty day" rule, and holds, as we submit it should hold, that any delay beyond thirty days after finality of adjudication of invalidity is "unreasonable", except under exceptional circumstances,* then it follows that the patentees' delay of eight months and thirteen days in entering disclaimers in the two patents involved in the present suit was "unreasonable", and that, in consequence, both patents are wholly invalid for that reason.

If, on the other hand, this Court is not inclined to adopt the "thirty day" rule, petitioners insist that in the instant case the delay of eight months and thirteen days, in any event, was "unreasonable". The patentees in the present case advance no extenuating circumstance of the character accepted by this Court in *Minerals Separation* v. *Butte, supra,* and, in addition, delayed a period nearly three times the duration of the delay in that case. The patentees here were not foreign inventors, and the country was not at war. Under such circumstances no conceivable justification could exist for a delay of that period in entering the disclaimer.

It is submitted, therefore, that the conclusion is inescapable that the delay in entering the disclaimer in the present case was "unreasonable" under the statute, and that both patents in suit are wholly invalid for that reason.

---

* Such "exceptional circumstances" existed in *Minerals Separation* v. *Butte,* 250 U. S. 336. In that case the patentee was in Europe, and there was an interference with communications with Europe due to the war. For that reason this Court excused a delay of three months in entering the disclaimer, but plainly indicated that it considered three months entirely too long under ordinary conditions.

Conclusion.

It is submitted that the judgment of the Court below should be reversed, and the decree of the Trial Court dismissing the bill of complaint as to the two patents in suit should be sustained.

Respectfully submitted,

SAMUEL E. DARBY, JR.,
Counsel for Petitioners.

COOK & MARKELL,
Attorneys for Petitioners.

CHARLES MARKELL,
of Counsel.

APPENDIX A.

Disclaimer.

1,635,117.—*Francis W. Dunmore,* Washington, D. C. SIGNAL-RECEIVING SYSTEM. Patent dated July 5, 1927. Disclaimer filed July 8, 1933, by the patentee and the exclusive licensee, *Dubilier Condenser Corporation.*

Hereby enter their disclaimer to:

(1) Any "source of alternating current power supply" in claim 1 except such as delivers rectified alternating current to said grid electrodes and raw alternating current to said filament electrodes; to any "means associated with said alternating current power supply for impressing a negative potential on said grid electrodes" in said claim 1, except such means as comprise a resistance in series with said grid electrodes shunted by a condenser; to any "means for energizing said filaments" as specified in claims 2, 3, 4, 5, and 6, except such means as supply raw alternating current to said filaments and to any "rectifier adapted to supply a negative potential to said grid electrodes" as specified in claims 2, 4, 5, and 6 except such as supply such negative grid biasing potential by means of a bias determining resistance in series with the grid electrodes and connected to the respective cathodes of the amplifying tubes and shunted by a condenser of low impedance to power supply frequencies.

(2) Any "filament electrodes" specified in claim 9 except such as are energized by raw alternating current; and any

"means for supplying a negative potential to the grid electrode of said electron tube from said source of alternating current" as specified in claim 9 except such means as comprise a bias determining resistance connected in a series path between the grid and filament electrodes and shunted by a condenser of low impedance to power supply frequencies.

(3) Any "source of power adapted to be energized by alternating current or the like" as specified in claim 11, except such as supplies raw alternating current to the cathode heating circuits of such tubes and rectified current to the grid circuits of such tubes; and to any "output terminals connected at opposite terminals of said resistance" as specified in said claim, except such as are also connected to the grid and cathode of the vacuum tube.

(4) Any "method of energizing thermionic vacuum tubes or the like from a source of alternating current" as specified in claim 12, except such as supplies raw alternating current to the cathode heating circuit of such tubes and rectified current to the grid circuit of such tubes; and to "impressing the desired portion of such voltage drop upon said thermionic tube" except to impressing the desired portion of the voltage drop upon the grid-cathode circuit of said thermionic tube.

[*Official Gazette August 1, 1933.*]

Disclaimer.

1,455,141.—*Percival D. Lowell* and *Francis W. Dunmore*, Washington, D. C. RADIO RECEIVING APPARATUS. Patent dated May 15, 1923. Disclaimer filed July 8, 1933, by the patentees and the exclusive licensee, *Dubilier Condenser Corporation.*

Therefore enter their disclaimer as follows:

(1) To any "source of alternating current for supplying power to said amplifying means" as set forth in claim 1 except such as supplies raw alternating current to the cathode heating circuit or circuits of such amplifying means and rectified current to the plate circuit or circuits of such amplifying means; to any "plurality of means in circuit with said amplifying means for eliminating the hum of said alternating current in said apparatus" except such means as comprises: (*a*) a connection from the grid to the amplifying means to the cathode thereof at a point not subjected to the influence of variations of the cathode heating current; (*b*) elements connected between the stages of said amplifying means which prevent the passage of power supply frequencies; and (*c*) a resistor shunted by a condenser interposed in the circuit between the grid and cathode of the amplifying means where said condenser forms a low impedance path for both signal and power supply frequencies and wherein the voltage drop across said resistor provides a negative bias for the grid of the amplifying means.

(2) To any "source of alternating current for supplying power to said amplifying means" as set forth in claim 2

except such as supplies raw alternating current to the cathode heating circuit or circuits and rectified current to the plate circuit or circuits; to any "means connected to said amplifying and rectifying means for eliminating the hum of said alternating current in said apparatus" except as comprises: (*a*) a connection from the grid of the amplifying means to the cathode thereof at a point not subjected to the influence of variations of cathode heating current; (*b*) elements connected between the stages of said amplifying means and between said amplifying and rectifying means which prevent the passage of power supply frequencies; and (*c*) a resistor shunted by a condenser interposed between the grid and the cathode of the amplifying means, where said condenser forms a low impedance path for both signal and power supply frequencies and wherein the voltage drop across said resistor provides a negative bias for the grid of the amplifying means.

(3) To any "source of alternating current for supplying power to said amplifying means" as set forth in claim 3 except such as supplies raw alternating current to the cathode heating circuit or circuits and rectified current to the plate circuit or circuits of such amplifying means; to any "separate means connected to each of said amplifying and rectifying means for eliminating the hum of said alternating current" except as comprises: (*a*) connecting the grid of the amplifying means to the cathode thereof at a point not subjected to the influence of variations of the cathode heating current, and (*b*) elements connected between the "means for amplifying said signal energy at radio frequencies" and the "means for rectifying said energy" which prevent the passage of power supply frequencies.

(4) To any "source of alternating current for supplying power to said amplifying means" as set forth in claim 4 except such as supplies raw alternating current to the cathode heating circuit or circuits of such amplifying means and rectified current to the plate circuit or circuits of such amplifying means; to any "means connected to each of said amplifying, rectifying, and reproducing means for eliminating the hum of the alternating current" except such as comprises: (*a*) connecting the grid of the amplifying means to the cathode thereof at a point not subjected to the influence of variations of the cathode heating current, and (*b*) elements connected between stages of the amplifying means and between the amplifying means and the rectifying means which prevent the passage of power supply frequencies.

(7) To any "means in different parts of said circuits for eliminating the hum of the alternating current" as set forth in claim 7 except such as comprises: (*a*) connecting the grids of said amplifying means to the cathodes thereof at a point not subjected to the influence of variations of the cathode heating current; (*b*) elements interconnecting the stages of the "means for amplifying said energy at radio frequencies" and elements interconnecting the "means for amplifying said energy at radio frequencies" with the "means for rectifying said energy" which prevent the passage of alternating current hum; and (*c*) such means as a resistor shunted by a condenser connected in a circuit between the grid and cathode of the "means for amplifying said energy at radio frequencies" where the said condenser forms a low impedance path for both signal and power supply frequencies.

(13) To any "means for supplying the rectified energy to circuits of said vacuum tube amplifiers" as set forth in claim 13, except such as supplies such rectified energy to the plate circuits of said vacuum tube amplifiers and also supplies raw alternating current to the cathode heating circuit or circuits of said amplifiers; to any "means connected in each of the circuits of said amplifiers, detector and reproducer for eliminating the hum of said alternating current" except such as comprises: (*a*) connecting the grids of the amplifiers to the cathodes thereof at a point not subjected to the influence of variations of the cathode heating current; (*b*) elements interconnecting the stages of said radio frequency vacuum tube amplifier and interconnecting the output of said radio frequency vacuum tube amplifier with the detector which prevent the passage of power supply frequencies; and (*c*) a resistor shunted by a condenser and connected in the circuit between the grid and cathode of each of said amplifiers, where the said condenser forms a low impedance path for both signal and power supply frequencies.

(14) To any "means in each of said circuits for eliminating the hum" as set forth in claim 14, except as comprises: (*a*) connecting the grids of vacuum tubes to the cathodes thereof at a point not subjected to the influence of variations of the cathode heating current, and (*b*) interconnecting the plurality of vacuum tubes which amplify the signal at radio frequencies through elements which prevent the passage of power supply frequencies.

(15) To any "vacuum tubes" as set forth in claim 15 except vacuum tubes which have the grid electrodes thereof connected with the cathodes thereof at a point not subjected to the influence of variations of the cathode heating current;

and to any "circuits interconnecting said electrodes and said detector" as specified in said claim except such circuits as include an inductively coupled radio frequency transformer.

(16) To any "source of alternating current for supplying power to said amplifying means" as set forth in claim 16 except such as supplies raw alternating current to the cathode heating circuit or circuits and rectified current to the plate circuit or circuits; to any "means connected in circuit with said rectifying means for smoothing out the rectified current and supplying power to said amplifying means" except such as prevents distortion of the signal current.

(18) To any "source of alternating current for supplying power to said circuits" as set forth in claim 18 except such as supplies raw alternating current to the cathode heating circuit and rectified current to the plate circuit or circuits of the vacuum tubes; to any "means connected in circuit with said grid and plate electrodes for eliminating the hum" except as compromises: (*a*) connecting the grids of the vacuum tubes to the cathode thereof at a point not subjected to the influence of variations of the cathode heating current, and (*b*) interposing filter elements in the plate circuit to reduce fluctuation in power supply frequencies; and to any "circuits interconnecting said electrodes" except as include a radio frequency transformer.

(19) To any "source of alternating current" as set forth in claim 19 except as supplies raw alternating current to the cathode heating circuit or circuits of said vacuum tubes; and to any "circuits interconnecting said electrodes"

except as include elements which prevent the passage of power supply frequencies.

(20) To any "source of alternating current for supplying power to said amplifying means" as set forth in claim 20 except as supplies raw alternating current to the cathode heating circuit or circuits of said amplifying means and rectified current to the plate circuit or circuits of said amplifying means.

(21) To any "source of alternating current for supplying power to said tubes" as set forth in claim 21 except as supplies raw alternating current to the cathode heating circuit or circuits and rectified current to the plate circuit or circuits of said tubes.

[*Official Gazette August 1, 1933.*]

APPENDIX B.

SEC. 4917. Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such

disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.

SEC. 4922. Whenever, through inadvertence, accident, or mistake, and without any willful default, or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer.

APPENDIX C.

The cases cited by the Court of Appeals for the Fourth Circuit in the footnote to its decision, and referred to as establishing "long continued practice in patent cases inconsistent" with petitioner's contentions here made.

As stated in our brief (*supra*, p. 16), the Court of Appeals below copied, *verbatim*, from the memorandum of plaintiff's counsel, as a footnote to its opinion, a list of cases and recitations of facts relative thereto grouped under several headings. The cases thus grouped and described purported to be those in which an adjudication of validity was secured in an action instituted subsequent to an adjudication of invalidity. As stated in our brief, the descriptions of these cases, with the exception of three, are erroneous or so incomplete as to raise an erroneous inference. Each case has been run down in each of the courts, and the correct and complete facts show the following:

Cases in the Supreme Court prior to the establishment of the Circuit Courts of Appeals (prior to the Act of 1891).

We are not here concerned with the practice prevailing prior to the Act of 1891, or prior to the enactment of the Revised Statutes. Under the present statutes a situation such as was presented in the *Barbed Wire* case could not possibly exist. In that case the original patent was held to be invalid, and was reissued. The reissue patent was then held to be invalid. Thereafter, the original patent was held to be valid. Obviously this procedure, permissible then but not now, is no guide to "long continued practice".

Cases in the Supreme Court where the patent was held invalid by the Circuit Court of Appeals for one Circuit and later held valid by the Circuit Court of Appeals for another Circuit.

1. *Expanded Metal Co.* v. *Bradford*, 214 U. S. 366.

The footnote of the Court of Appeals says as to this case:

> "After the decree in the Circuit Court of Appeals for the Third Circuit (invalidating the patent) plaintiff filed a bill against another defendant in the Northern District of Ohio."

The fact is just contrary to the statement. The decree of the Third Circuit was on September 10, 1906, and the bill in the Ohio Court was filed on February 10, 1904.

2. *Diamond Rubber Co.* v. *Consolidated Rubber Tire Co.*, 220 U. S. 428.

The first decision on this patent, rendered by the District Court in the Southern District of New York (91 Fed. 978), held the patent to be valid. No appeal was ever taken from that decision, so that throughout all subsequent litigation there was an outstanding opinion of validity for the patent. Thus the decision of invalidity of the Court of Appeals for the Sixth Circuit was in conflict with a prior decision of validity. The Court of Appeals for the Second Circuit, in a subsequent suit, adhered to the prior adjudication of validity, and because of the diversity of opinion between the Second and Sixth Circuits thus resulting, this Court reviewed the case and found the patent to be valid.

The correct recitation of facts as to this case, therefore, negatives the thought that the first adjudication received by the patent was one of invalidity.

3. *Dowagiac Manufacturing Co.* v. *Minnesota Moline Plow Co.*, 235 U. S. 641.

The description of this case contained in the footnote to the decision of the Court of Appeals below shows that it did not involve the issue of validity. In consequence it is not pertinent to the present inquiry.

4. *Hanover Star Milling Co.* v. *Metcalf*, 240 U. S. 403.

This was a trade-mark case and has no applicability to the present question, or to the disclaimer statute.

5. *Railroad Supply Co.* v. *Elryia Iron & Steel Co.*, 244 U. S. 285.

The recitation of the facts of this case in the footnote to the opinion of the Court of Appeals below shows that the cases were "copending".

6. *Abercrombie & Fitch* v. *Baldwin*, 245 U. S. 198.

The facts in this case were entirely different from those as set forth in the footnote. The first adjudication the patents received was in an unreported case in the Southern District of Illinois in which both patents involved in the suit were held to be valid. The Court of Appeals for the Seventh Circuit next passed on the patents on appeal, and held both patents valid (199 Fed. 133) (the footnote of the Court of Appeals below incorrectly states that the Court of Appeals for the Seventh Circuit held the patents to be invalid). Thereafter one of the patents was reissued and held to be valid by the District Court for the Western Division

of Pennsylvania, 215 Fed. 735. The Circuit Court of Appeals for the Third Circuit held the patent to be invalid (219 Fed. 735). Its decision was rendered on January 22, 1915, and on February 6, 1915, in a copending case awaiting decision after trial, the District Court for the Southern District of New York held the patent to be valid (227 Fed. 455), which decision was affirmed by the Court of Appeals for the Second Circuit (228 Fed. 895).

From the foregoing recitation of facts it is apparent that the first, second and third adjudications the patent received were of validity. Diversity of opinion therefore occurred in a copending case, which resulted in this Court reviewing the dispute. In consequence this case completely fails to support the suggestion of the Court below, but rather completely supports the contentions herein made by petitioners.

7. *T. H. Symington* v. *National Malleable Castings Co.*, 250 U. S. 383.

The recitation of the facts in this case is highly misleading due to the incompleteness thereof. The chronology of the litigation was as follows. On August 6, 1914, the District Court for the Northern District of Illinois, Eastern Division, held the Emerick Patent No. 693,643 valid and infringed (216 Fed. 198). On October 5, 1915, the Court of Appeals for the Seventh Circuit affirmed (229 Fed. 730). On April 8, 1915, the District Court of Maine held Byers Patent No. 673,419 not infringed and did not pass on validity (222 Fed. 517). On February 3, 1916, the Court of Appeals for the First Circuit held the Byers patent valid and

infringed (230 Fed. 821). On rehearing the Court of Appeals affirmed its previous decision on June 8, 1916 (234 Fed. 343). This Court granted writs of certiorari to both Circuits because the inventions were substantially the same, and affirmed the Court of Appeals for the First Circuit, and reversed the Court of Appeals for the Seventh Circuit (250 U. S. 383). Thus, there was no issue in this case comparable to that here presented. Two entirely different patents issued to different inventors were involved and both of them were held to be valid by the lower Courts.

8. *Meccano Limited* v. *John Wanamaker*, 253 U. S. 136.

The description of this case in the footnote shows that there was a case pending at the time the decision of invalidity was received, and it was the prosecution of that case that resulted in an adjudication of validity.

9. *New York Scaffolding Co.* v. *Chain Belt Co.*, 254 U. S. 32.

Here again the facts have been misstated. The Court of Appeals for the Eighth Circuit did not, as stated in the footnote, hold the patent to be invalid in *New York Scaffolding Co.* v. *Whitney*, 224 Fed, 452. On the contrary, the patent was declared to be valid. In consequence this case does not support the suggestion of the Court below.

10. *John E. Thropp's Son's Co.* v. *Seiberling*, 264 U. S. 320.

This case has no bearing on the present inquiry because disclaimers were actually filed with reference to the claims which had been held to be invalid, as noted in the footnote of the Court of Appeals below.

11. *Corona Cord Tire Co.* v. *Dovan Chemical Corp.*, 276 U. S. 358.

This is the only case thus far recited which supports the suggestion of the Court of Appeals below. Obviously this case alone does not establish "long continued practice." Moreover, the existence or applicability of the disclaimer statute was not raised, and in any event, this Court, which reviewed the case because of diversity of opinion between the Court of Appeals for the Second and Third Circuits, held the patent to be invalid.

12. *Saranac Automatic Machine Corp.* v. *Wirebound Patents Co.*, 282 U. S. 704.

The correct facts of this case are that the Court of Appeals for the Seventh Circuit held the patent to be invalid on February 6, 1928 (25 Fed. [2] 363). The opinion of the Court of Appeals for the Sixth Circuit, which held the patent to be valid, was in a suit which had been instituted in the District Court before the invalidating opinion of the Court of Appeals for the Seventh Circuit. Thus the District Court's decision, 24 Fed. [2] 872 which was reviewed by the Court of Appeals for the Sixth Circuit (37 Fed. [2] 830), was rendered on July 9, 1927, nearly a year before the invalidating decision of the Court of Appeals for the Seventh Circuit. Thus, here again, and contrary to the inference to be derived from the recitation of this case in the footnote to the opinion of the Court of Appeals below, the first adjudication was not one of invalidity, and the patentee was diligently endeavoring to vindicate his position in copending litigation instituted and submitted prior to the decree of invalidity.

13. *Radio Corp.* v. *Radio Engineering Laboratories*, 293 U. S. 1.

This case has nothing whatever to do with the question here before the Court. The issue was priority of invention. This Court held that DeForest was the prior inventor of the subject matter of his patents. Subsequently the Court of Appeals for the Second Circuit concluded otherwise—an error which this Court later corrected (78 L. Ed. 1453).

Cases in Circuit Courts of Appeals where the patent was first held to be invalid by one Circuit Court of Appeals and later held to be valid by another Circuit Court of Appeals (omitting cases which reached the Supreme Court).

1. *Maitland* v. *B. Goetz Manufacturing Co.*, 86 Fed. 124.

This case has no bearing whatever on the present inquiry because of the fact, as recited in the footnote of the Court of Appeals below, that after the decree of invalidity the patent was reissued by narrowing the claim which had been held to be invalid, and the reissue claim was subsequently held to be valid. This was proper procedure, and had nothing whatever to do with disclaimer as this Court pointed out in *Altoona Publix Theatres* v. *American Tri-Ergon*, 294 U. S. 477.

2. *McNeely* v. *Williames*, 96 Fed. 978.

Here, again, the description of this case misstates the facts. The Court in the Southern District of New York on February 12, 1890, held claims 1 and 3 valid and some of the remaining claims (Nos. 2, 5 and 7) invalid (41 Fed. 358). The Court said that on the filing of disclaimer of the invalid

claims the decree would be entered. In the Eastern District of Pennsylvania the Court on December 4, 1894, also held claims 1 and 3 valid (64 Fed. 766). As the opinion of the Court in that case pointed out, the defendant argued that the patent was void for failure to file disclaimers after the previous case. *The Court said that the time for taking the appeal had not yet expired,* and therefore the patentee could either disclaim or appeal from the decision in the New York case. The Court of Appeals for the Third Circuit then held claims 1 and 3 valid, and also held the remaining claims (2, 5, and 7) valid, though they were not involved in the suit. Therefore, it is obvious that the Court of Appeals for the Third Circuit recognized the necessity of filing the disclaimer or of appealing, and found validity for the claims during a period within which an appeal could be taken.

3. *Westinghouse Electric & Manufacturing Co.* v. *Stanley Instrument Co.*, 133 Fed. 167.

Here, again, the recitation of the case in the footnote to the opinion of the Court of Appeals is erroneous. Chronologically, the facts are as follows:

On May 17, 1899, the Court in the Southern District of New York held that Patent No. 511,559 was not void on its face on demurrer (94 Fed. 868). On September 27, 1899, the Court in the Eastern District of Pennsylvania held that patent, together with Patent No. 511,560, valid and infringed (97 Fed. 588). On February 6, 1901, the Court for the Southern District of Ohio, Western Division, held both patents valid and infringed (106 Fed. 274). On August 22, 1901, the District Court for the Southern District of New

York held both patents valid and infringed (110 Fed. 377). On November 5, 1902, the Court of Appeals for the Sixth Circuit held both patents to be valid and infringed (118 Fed. 562). On February 25, 1903, the Court of Appeals for the Second Circuit held the patents to be invalid (121 Fed. 831).

From the foregoing it will be seen that the patents had received four adjudications of validity before the decision of invalidity. This case, therefore, does not, in the slightest sense, support the suggestion of the Court of Appeals below.

4. *Thompson-Houston Electric Co.* v. *Black River Traction Co.*, 135 Fed. 759.

This is another case where the patent was held to be invalid and then reissued to cure the invalidity. The footnote of the opinion of the Court of Appeals below states with reference to this case:

> "It was held that the reissued claim was not for different inventions and that the claim was valid."

The opinion of the Court is directly to the contrary. The Court held that it was for different inventions (see 135 Fed. 759). Obviously, this case has no applicability to the present question, and affords no support for the suggestion of the Court below.

5. *Imperial Bottle Cap and Machine Co.* v. *Crown Cork & Seal Co.*, 139 Fed. 312.

As appears from the recitation of the facts of this case in the footnote, two cases were pending decision at the same time, by two different Circuit Courts of Appeals. Quite obviously, therefore, the patentee was diligently en-

deavoring to vindicate his assertion of validity for his patent. In consequence, this case does not support the suggestion of the Court of Appeals below.

6. *Pieper v. S. S. White Dental Manufacturing Co.*, 228 Fed. 30.

This is the second case referred to which apparently supports the suggestion of the Court of Appeals below. However, the existence and effect of the disclaimer statute was not at issue or called to the attention of the Court, and the decision in the case was rendered prior to the decision of this Court in the *Ensten* case.

7. *Backstay Machine & Leather Co.* v. *Hamilton*, 262 Fed. 411.

This is the third case referred to which apparently supports the suggestion of the Court of Appeals below. Here again, however, the existence or applicability of the disclaimer statute was not in issue or called to the attention of the Court, and the decision was rendered prior to the decision of this Court in the *Ensten* case.

8. *Wenborne-Karpen Dryer Co.* v. *Cutler Dry Kiln Co.*, 290 Fed. 625.

In this case the decree of invalidity was rendered while a suit on the same patent was pending and being actively prosecuted in another Court. In consequence, the case does not support the suggestion of the Court of Appeals below.

9. *Franc-Strohmenger & Cowan* v. *Arthur Siegman*, 27 Fed. (2) 785.

In this case the Court of Appeals for the Sixth Circuit held the patent invalid on July 8, 1927 (27 Fed. [2] 553). On February 21, 1928, the District Court for the Southern District of New York held the patent to be valid (25 Fed. [2] 108) in a suit where the bill had been filed prior to the decision of the Court of Appeals for the Sixth Circuit.

Summary.

From the foregoing it will be seen that of the long list of cases cited in the footnote of its opinion by the Court of Appeals below there are only three cases which support its suggestion that

> "the long continued practice in patent cases is inconsistent with defendant's contention that an adverse decision on any claim of the patent requires the prompt filing of a disclaimer thereof with the result that it may never be litigated again".

As to those three cases, the existence or applicability of the disclaimer statute was not at issue, or called to the attention of the Court, and they were all decided before this Court's decision in the *Ensten* case.